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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,510	02/27/2004	Muhammad Chishti	018563-004920US	7442

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EXAMINER	
WILSON, JOHN J	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/788,510	CHISHTI ET AL.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/22/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 2 and 3, the preamble is directed to a method for fitting a set of upper and lower teeth in a masticatory system, which method is described in the disclosure, however, the method steps of the body of these claims are not directed to, and do not accomplish, the claimed method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2-5 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martz (4793803). Martz teaches modeling teeth with plaster and wax, column 3, line 65, through column 4, line 15, and teaches modeling multiple stages for generating multiple appliances for each stage, column 4, lines 12-15 and column 5, lines 4-12. Martz teaches multiple stages, however, does not specifically show three or more. To use three or more positions would be an obvious matter of choice in the specific range of number of times needed to best move the teeth

to one of ordinary skill in the art. Each model of Martz is inherently made prior to the treatment preformed in that stage of moving teeth in which it is used. Further, if the claim language were to be read as meaning that all of the modeling was done before the first stage of treatment, then, it is held that it would be obvious to one of ordinary skill in the art to make the multiple stages of Martz at the beginning in order to not make the patient return each time for another appliance. As to claim 4, see column 3, line 48. As to claim 5, Martz teaches using an articulator, column 3, lines 58-61. It is well known to use articulators to check contact between teeth when modeling casts. As to claim 9, Martz teaches moving the casts, column 3, lines 58-60. As to claim 10, and articulator inherently has constraints such as the hinge axis it pivots on. As to claims 11-13, to place avoid undesirable contact would have been obvious to the skilled artisan. As to claim 14, the specific calculations used is an obvious matter of choice in known calculation methods to one of ordinary skill in the art.

Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martz (4793803) in view of Duret et al (4611288). Martz does not show using data from X-rays. Duret teaches using X-ray data to obtain dynamic occlusion, column 14, lines 25-33. It would be obvious to one of ordinary skill in the art to modify Martz to include using X-ray data to model occlusion as shown by Duret in order to make use of known ways to better model teeth.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martz (4793803) in view of Andreiko et al (5683243). Martz does not show using data from tomography. Andreiko teaches using tomography data to model teeth, column 5, lines 15-17. It would be

obvious to one of ordinary skill in the art to modify Martz to include using tomography data to model occlusion as shown by Andreiko in order to make use of known ways to better model teeth.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-40 of U.S. Patent No. 6,450,807 in view of Martz (4793803). To use the method of the claims of the '807 patent to generate the appliances of Martz would have been obvious to one of ordinary skill in the art looking to better form the appliances. Each model of Martz is inherently made prior to the treatment preformed in that stage of moving teeth in which it is used. Further, if the claim language were to be read as meaning that all of the modeling was done before the first stage of treatment, then, it is held that it would be obvious to one of ordinary skill in the art to make the multiple stages of Martz at the beginning in order to not make the patient return each time for another appliance.

Allowable Subject Matter

Claims 21-24 stand rejected under double patenting only.

Response to Arguments

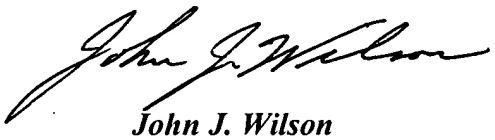
Applicant's arguments filed November 10, 2005 have been fully considered but they are not persuasive. The claim language is broadly stated in that the term treatment is not limited, and Martz inherently shows making models before the treatment of the patient for each model begins. Applicant argues that Martz does not show generating appliances before treatment, however, the claims are not limited to this argued step, the claims are only limited to modeling the positions prior to treatment. Further, the step is held to be obvious as stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
December 23, 2005